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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Paper No. 1

Application Number: 09/928,884
Filing Date: August 14, 2001
Appellent(s): LAWLYES ET AL.

Thomas E. Donohue (Reg. No. 44,660)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed February 11, 2004.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The rejection of claims 8 and 13-15 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

The rejection of claims 9-12 and 16-17 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

Natsume U.S. Patent No. 5,764,487

Denzene U.S. Patent No. 6,219,258

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 8 and 13-15 are rejected under 35 U.S.C. 102(b) as being unpatentable by Natsume U.S. Patent No. 5,764,487. Natsume teaches an engine controller comprising a main assembly board 28, a main assembly housing 24, 26, and a pre-assembled partitioned circuit assembly having a partitioned circuit element 16 mounted within a partitioned circuit housing 22 and a plurality of connectors 32, said plurality of connectors placing said partitioned circuit element in communication with said main assembly board when said partitioned circuit assembly is inserted into said main assembly housing, wherein said main assembly housing includes at least one main assembly port 20, said at least one said assembly port allowing said partitioned circuit assembly to be inserted into said main assembly board through main assembly housing, wherein the engine controller further comprises at least one communication port 36 (Col. 3, lines 20+; Col. 4, lines 1+; FIG. 1-2).

Claims 9-12 and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Natsume U.S. Patent No. 5,764,487 in view of Denzene U.S. Patent No. 6,219,258 B1. Natsume teaches an partitioned circuit assembly for integration and removal from an engine controller comprising a main assembly board 28, a main assembly housing 24, 26, and a pre-assembled partitioned circuit assembly having a partitioned circuit element 16 mounted within a partitioned circuit housing 22 and a plurality of connectors 32, said plurality of connectors placing said partitioned circuit element in communication with said main assembly board when said partitioned circuit assembly is inserted into said main assembly housing (Col. 3, lines 20+; Col. 4, lines 1+; FIG. 1-2). Natsume does not teach a partitioned circuit assembly further comprising a heat sink element, a passivation material, or a seal element. Denzene teaches pre-assembled circuit assembly comprising a heat sink element (not explicitly numbered, referred to as fins on the inner/outer surfaces Col. 5, lines 25-32), a passivation material 90 positioned within said partitioned circuit housing (Col. 2, lines 27+; Col. 6, lines 46+; Col. 7, lines 1+), a seal element 110 such that said partitioned circuit assembly becomes sealed to said main assembly housing after said partitioned circuit assembly is inserted into said main assembly board (Col. 8, lines 23+). Denzene does not teach a pre-assembled partition circuit assembly further including a heat sink attached using thermally conductive material. Electronic devices or components generate heat, which creates interference within the electronic assembly and decreasing the accuracy of the signals and results. It would be obvious to a person skilled in the art to adapt the pre-assembled circuit assembly of the Natsume reference to include a heat sink element, passivation material,

and a seal element in order to protect the inner components of the assembly from EMI interference and environmental pollution. It is known to provide a heat sink, heat dissipation device, or cold plate in conjunction with a circuit assembly in order to minimize the dissipation of heat and the subsequent interference problems that accompany the excess heat produced. By providing a heat sink and other sealant elements, the Applicant is merely attempting to remedy a common problem within the electronic industry, and thus not providing an improvement on an existing product, therefore the inclusion of the heat sink does not constitute patentability.

(11) Response to Argument

Regarding Claims 8 and 13-15, Applicant argues that "partition circuit assembly" is not taught by the Prior Art. Claim 8 recites such an element without any functional language. Claim 15 broadly claims a "partitioned circuit element," which does not recite any functionality of the element. In the Appeal Brief, the Applicant further cites paragraph 15 in the present application that the partitioned circuits adds functionality to the main assembly (Appeal Brief, page 5, lines 2+). In response, the Examiner points that a relay or fuse does in fact add functionality to a main assembly as shown in the Natsume reference.

In response to applicant's arguments, the recitation "engine controller" has not been given patentable weight because the recitation occurs in the preamble. A preamble is

generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). The apparatus of Natsume is not only for use in an automotive vehicle, but also includes all elements and limitations presented. Nowhere in the Claims does the Applicant include environmental or manufacturing constraints or limitations that differentiate between the engine controller of the Applicant's invention and that of the Natsume reference. For the foregoing reasons, Claims 8 and 13-15 continue to be anticipated by the Natsume references. Accordingly, the Examiner's rejection over the Natsume reference under 35 U.S.C. 102(b) is upheld.

Regarding Claims 9-12 and 16-17, in response to applicant's argument that Denzene is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the Applicant asserts that the Denzene reference which teaches an outdoor telecommunications box is non-analogous to an engine controller. The Applicant gives no specific environmental conditions that would preclude the Denzene reference from being combined with the Natsume reference in the present

case. As was established in prior rejections, heat sinks are utilized throughout the electronics industry to provide cooling to heat producing elements in an electronic apparatus, as well as seals are provided to seal an element or apparatus in protection from outside element interference or damage. To provide multiple heat sinks to multiple elements or to provide a single heat seat for a plurality of elements is a matter of using multiple parts for a greater effect, which has been established in case law to be an obvious step in the art since it has been held that using duplicate parts for a multiplied effect involves only routine skill in the art (*St. Regis Paper Co. vs. Bemis Co.*, Inc. 193 USPQ 8, 11 (7th Cir. 1977)). Providing a seal to an element or apparatus in different locations would have been obvious to a person skilled in the art at the time of the invention since it has been held that rearranging parts of an invention involves only routine skill in the art (*In re Japikse*, 86 USPQ 70).

Further, the Applicant again asserts environmental conditions, such as temperature and vibration in the Appeal Brief in regards to the Denzene reference. Because the telecommunications box assembly of the Denzene reference utilized for outdoor use, it is constructed to withstand a variety of environmental conditions, such as heat, wind, and rain. Again, nowhere in the Claims does the Applicant provide any evidence that these environmental conditions hinder the Natsume reference alone, or in this case, in combination with Denzene. For the foregoing reasons, Claims 9-12 and 16-17 continue to be anticipated by the combination of the Natsume and Denzene references.

Accordingly, the Examiner's rejection over the Natsume and Denzene combination under 35 U.S.C. 103(a) is upheld.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Michael L. Lindinger
Examiner
Art Unit 2841

MLL
March 29, 2004

Conferees

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